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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/694,106	10/27/2003	Martin Kleban	CH-7867/LeA 36,309	3077

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EXAMINER

GREEN, ANTHONY J

ART UNIT	PAPER NUMBER
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1755

DATE MAILED: 09/21/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/694,106

Applicant(s)

KLEBAN ET AL.

Examiner

Anthony J. Green

Art Unit

1755

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-12 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-12 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 04/30/04.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_.

***Claim Rejections - 35 USC § 112***

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 1-12 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 1 it is unclear as to what is meant by "according to DIN 53338".

In claim 6 it is unclear as to what is meant by "according to DIN 53333".

Claim 8 is confusing as written as it depends from claim 7 which already seems to suggest that the silicone is used as water repellent.

Claim 9 is inconsistent with claim 9 as claim 9 refers to "leather" and not "leathers".

Claim 12 is confusing as written as it is unclear as to how the step of "providing" prepares the material. Clarification is requested.

***Claim Rejections - 35 USC § 102***

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 1-2, 6-9 and 12 are rejected under 35 U.S.C. 102(b) as being anticipated by German Patent Abstract No. 19629986.

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The abstract teaches leathers tanned with polymers which are waterproofed with polysiloxanes.

The instant claims appear to be met by the reference as the reference teaches the use of the same materials to waterproof the leather. As for the properties of the treated leather (i.e. waterproofness and vapour permeability) these properties appear to be inherent properties, absent evidence showing otherwise, since the leather is treated with similar materials.

***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 1-2, 6-9 and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over European Patent Specification No. 757,108.

The reference teaches, in the abstract and on page 4, lines 35, a method for waterproofing leather using an aqueous dispersion of silicone oil emulsified with a water insoluble amphiphilic copolymer. While the invention concerns the use of chrome tanned leather, according to page 4, lines 35 the method may be used with other types of hides and skins such as mineral (aluminum, zirconium, titanium and magnesium) tanned animal substrates.

The instant claims are obvious over the reference. While the reference does not specifically teach the treatment of non-chrome tanned hides with the silicone oil waterproofer, it does suggest that it may be used for other types of hides. Accordingly it is within the level of ordinary skill in the art to utilize leathers tanned with other non chrome materials since this is at least suggested by the reference and thus arrive at the instant invention. As for the properties of the treated leather (i.e. waterproofness and vapour permeability) these properties would appear to be inherent and/or obvious properties, absent evidence showing otherwise, resulting from the use of the waterproofing materials of the reference since the reference suggests the use of similar materials to waterproof leather.

7. Claims 1-2, 6-9 and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Siegler et al (US Patent No. 4,740,211 and 4,784,664).

The references each teach a non-chrome tanning method for treating leather. The references also teach (in column 6, lines 13+ for 4,740,211 and lines 39+ for 4,784,664) that the leather may be treated with a silicone resin finish in order to waterproof and/or finish them for use in weather-resistant footwear.

The instant claims are met by the references. While the references do not provide a specific example wherein the non-chrome tanned leathers are treated with a silicone resin, they do teach that one may treat them with silicone resin in order to waterproof them for use in weather-resistant footwear. Accordingly it would have been obvious to one of ordinary skill in the art to treat the non-chrome leathers with a silicone

resin and thus arrive at the instant invention, absent evidence showing otherwise. As for the properties of the treated leather (i.e. waterproofness and vapour permeability) these properties would appear to be inherent and/or obvious properties, absent evidence showing otherwise, resulting from the use of the waterproofing materials of the reference since the reference suggests the use of similar materials to waterproof non-chrome tanned leather.

***Allowable Subject Matter***

8. Claims 3-5 and 10-11 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims and provided that any 112 rejections, if any, are overcome.

***Information Disclosure Statement***

9. The remaining references cited by applicant (with the exception of reference AR) have been considered however they are not seen to teach and/or fairly suggest the instant invention. The "AR" reference has not been considered as it is not in the English language and applicant has not provided a concise explanation of the relevance of this reference.

***References Cited By The Examiner***

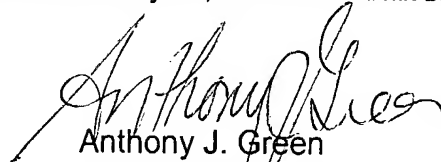
10. The references are cited as showing the general state of the art and as such,

they are not seen to teach or fairly suggest the instant invention.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Anthony J. Green whose telephone number is 571-272-1367. The examiner can normally be reached on Monday-Thursday 6:30-4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mark L. Bell can be reached on 571-272-1362. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Anthony J. Green  
Primary Examiner  
Art Unit 1755

ajg  
September 17, 2004